



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/461,265	12/15/1999	NEIL MASON	CS1061#SP	3583

7590 05/07/2002

BRUCE S SHAPIRO-TW199  
PATENT DEPARTMENT  
THE BLACK & DECKER CORPORATION  
701 EAST JOPPA ROAD  
TOWNSON, MD 21286

EXAMINER

GOODMAN, CHARLES

ART UNIT PAPER NUMBER

3724

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/461,265

Applicant(s)

MASON, NEIL

Examiner

Charles Goodman

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-19 is/are allowed.
- 6) ☒ Claim(s) 1-11, 13 and 14 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

DETAILED ACTION

1. The Amendment filed on October 2, 2001 has been entered.

*Continued Examination Under 37 CFR 1.114*

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 2, 2001 has been entered.

*Claim Rejections - 35 USC § 102*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-3, 8, 10, 11, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Vannuvel (BE 440,688).

Vannuvel discloses a saw blade clamping arrangement comprising all the elements claimed including, *inter alia*, a reciprocable shaft 1; a retaining member 7, 8 being lockable in at least two positions; and a restraining means 2. See whole patent.

Regarding the "adapted to couple..." language in claim 1, it has not been given significant patentable weight, since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability

Art Unit: 3724

to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

5. Claims 1-8, 10, 11 and 13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Huang.

Huang discloses a saw blade securing mechanism comprising all the elements claimed including, *inter alia*, a reciprocable shaft 20; a retaining member 52, 53 being lockable in at least two positions; restraining means 40, 201, 202; and recess 21. See whole patent.

Regarding the "adapted to couple..." language in claim 1, it has not been given significant patentable weight, since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

#### *Claim Rejections - 35 USC § 103*

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vannuvel (BE 440,688).

Vannuvel discloses the invention substantially as claimed except that it does not appear that Vannuvel includes a plurality of pairs of arms. However, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Vannuvel with a plurality of arms to facilitate additional positioning means for saw

Art Unit: 3724

blades of various lengths, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang.

Huang discloses the invention substantially as claimed except for a plurality of pairs of arms. However, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Huang with a plurality of arms to facilitate reinforced mounting of the saw blade, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

#### ***Allowable Subject Matter***

9. Claims 15-19 are allowed.

10. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

11. Applicant's arguments filed May 16, 2001 have been fully considered but they are not persuasive.

Art Unit: 3724

In response to Applicant's basic argument that the references do not anticipate the claimed invention,<sup>1</sup> this argument lacks merit. First, it is irrelevant whether the references use threaded fasteners since the claims do not make a distinction for consideration thereof. Second, the "retaining members" in the references are lockable in at least two positions because they are locked at different positions of the blade. Moreover, the position of these "retaining members" would be changed depending on the how the resulting end position of the retaining members when they are fastened. Applicant is again reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### *Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap, can be reached on (703) 308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

---

<sup>1</sup> Amendment C, Paper No. 13, p. 4, l. 5 - p. 5, l. 12.

Application/Control Number: 09/461,265

Page 6


Art Unit: 3724



**Charles Goodman**

**Primary Examiner**

**AU 3724**

cg   
May 6, 2002